UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,617	06/30/2003	Bryan Y. Roe	042390.P15965	1380

45209   7590   12/11/2008
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EXAMINER
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ART UNIT	PAPER NUMBER
2191	

MAIL DATE	DELIVERY MODE
12/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/611,617	ROE ET AL.
	Examiner	Art Unit	
	TED T. VO	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _15 September 2008_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,4-7,10-13 and 16-18_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,4-7,10-13 and 16-18_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _09/15/08_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is in response to the amendment filed on 09/15/2008.

Claims 1, 4-7, 10-13, 16-18 are pending in the application.

Information Disclosure Statement

2.   The contents of information disclosure statement filed 09/15/2008 which are lined

through fail to comply with the provisions of 37 CFR 1.98. The content of information which is

an Examiner office action **cannot be listed in a printing patent**. In accordance to 37 CFR 1.98

(a) (2) (ii) or (iv), the considered portions will be listed:

> (ii)   Each publication or that portion which <u>caused it to be listed</u>, other than U.S.
> patents and U.S. patent application publications unless required by the Office;
> (iv)   All other information or that portion which caused it to be listed.

Thus, content submitted under 37 CFR 1.98 when being initialed will cause to be listed

in a printing patent. Therefore, pursuant to 37 CFR 1.98, those contents of information should be

submitted as U.S. patents, U.S. patent application publications, and/or pending unpublished U.S.

applications. An office action cannot be the portion which is <u>caused to be listed</u>.

As per request for considering the portions/contents that are the internal Examiner office

actions, these portions/contents **<u>are considered by the Examiner</u>**, but they are lined through

because of 37 CFR 1.98 (a) (2) (ii) or (iv).

Response to Arguments

3.   This is in response to the argument remarks filed on 09/15/08.

In response to the statement "The brief summary is not required" submitted within the

Objection to The Specification; Examiner would like to submit that there is no section in the

MPEP for addressing "The brief summary of the invention is not required". It is instead address

that A brief summary of the invention indicating its **nature and substance, which may include**

a statement of the object of the invention, should precede the detailed description. Such

summary should, when set forth, be commensurate with the invention as claimed and any object

recited should be that of the invention as claimed.

Thus, an attempting (i.e. without "The brief summary of the invention") appears that an

application does not make publics understanding the invention; it cannot assist the examination

with proper searches.

Through the claims of this application, it seems the invention of this application is merely

for compiling a customized program. Thus, it is unclear to determine the patentability for this

application in which it is solely for generating a program, customized by a user, and then

compiling as usual? The Examiner fails to find out any explanations.

In response to the argument remarks relating the submissions of other Examiner's "Office

action", where the citations are in the section NPL of the form PTO 1447, Examiner will

consider. However, "office action" <u>cannot be considered as a prior art</u>. It should be noted that the

references submitted in NLP constitute "prior arts" which might be used by the examiner for

rejecting the claims. If consider "office action" as prior art, it is improper to use another

Examiner's office action to reject a current claim. Therefore, Applicant should cite a US patent'

application serial number or the US patent publication, instead.

It appears Applicant's argument remarks submitted that no prior arts disclose "generating

control point code". In response to the argument remarks relating the art rejections, generating

control point code is solely an act for writing a program. Thus, the argument remarks admitted

that the method is merely generating code and compiling it. In program execution, compiling is

a must act. It is not necessary for the skills in the art to mention the word "compile" when they

generate a program or have it for execution.

Furthermore, it has been too obvious that when a computer running a task, before the

existence of "task", a user/developer must write a computer program to function the task. The act

for generating custom source code is only another term for writing the code manually to function

the task and having it running in a computer. Thus, in order to run this computer program, it

requires compiling. The claimed recitations "*generating custom source code based on the*

accessed information, without utilizing a control point stack, to efficiently implement the control

point on the device by including only the services associated with the device", and "*compiling the*

source code to generate the control point" read on the common activity of writing a program;

particularly, for a standard set forth by UPnP. In fact, there is no need for Aho to combine since

the compilation is inherent in the program execution. However, it appears the claims attempt to

take the weight for compilation, the combination with Aho is obviously necessary.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner
> and process of making and using it, in such full, clear, concise, and exact terms as to
> enable any person skilled in the art to which it pertains, or with which it is most nearly
> connected, to make and use the same and shall set forth the best mode contemplated by
> the inventor of carrying out his invention.

5.   Claims 7, 10-12 are rejected under 35 U.S.C. 112, first paragraph, as based on a

disclosure which is not enabling. "Storage medium" is not included in the specification. This

limitation is critical or essential to the practice of the invention, but not included in the

specification to support the claims.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 1, 3-7, 9-13, 15-18 are rejected under 35 U.S.C. 112, second paragraph, as failing

to set forth the subject matter which applicant(s) regard as their invention. Evidence that the

specification fails to point out clearly what it regards in the invention.

        Per Claims 1, 3-7, 9-13, 15-18: Claims recite *generating custom source, tailored to the*

*device, **without utilizing a control point stack**, to sufficiently implement the control point on the*

device based on at least one of the device-specific information and the platform information. As

noted that the specification fails to point out the scope of the invention, while claims as a method

comprising, "..." included with this recitation. However, in order to function "without utilizing a

control point stack", the claim fails to show <u>inter-steps in its steps</u> for how it can perform or can

be performed "without". The claims merely preempt for covering everything. Thus, it is

unknown the boundary of generation step, and how it could be achieved without using a control

point stack.

Because of with or without does not cause any change or effect to the claim as a whole,

the claimed functionality is seen and interpreted as *"generating custom source code".*

Per Claim 16: Dependency in Claim 16 is improper. It is dependent on a canceled claim.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

9.   Claims 1, 4-7, 10-13, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Akkaoui et al, "Java Software Development KIT (SDK) For UPnP control point", 4-2003,

in view of Aho et al, "Compilers Principles, Techniques, and Tools", 1998.

        Given the broadest reasonable interpretation of followed claims in light of the specification.

<u>As per Claim 1</u>: Akkaoui discloses,

A method, comprising:

- accessing at least one of device-specific <u>information</u> or platform information for a device that

will implement a peer-to-peer network connectivity control point, <u>wherein the accessed</u>

<u>information indicates one or more services associated with the device</u>

See p. 2, Figure 2, having UI to access device-specific information or platform information, i.e. a

controller or MVC, an enhancement of control point, generated by Java (p.2, right column,

second paragraph) as shown in the devices of Figure 1, standardized by UPnP, the UI provides

the a energetic application built using the SDK.

- generating custom source code <u>based on the accessed information</u>, without utilizing a control

point stack, to efficiently implement the control point on the device <u>by including only the</u>

<u>services associated with the device</u>

        See sec. 3, p. 2-3, and Figure 2, the design of a UPnP enhancement, that is UPnP Control

point SDK, and does not using a control point stack from UPnP.

- tailored to the device <u>without utilizing a control point stack</u>, to efficiently implement the control point on the device <u>based on at least one of the device-specific information and the platform information</u>

See entire sec. 3.

Akkaoui does not mention the Java code generating for UPnP Control Point SDK design is "compiled" for limitation, ***compiling the source code to generate the control point***.

However, Aho shows that all source code has to compile because a processor recognizes only machine code. It is easily to recognize the Aho's teaching as its title.

Therefore, it would be obvious to the ordinary in the art to include a must "compiling" as of Aho to the code that generates for UPnP control point SDK, because compiling is a requirement for generating executable code.

<u>As per claim 4</u>: Incorporated to Claim 1, Akkaoui further discloses, *The method according to claim 1 wherein accessing the device-specific information further comprises receiving device-specific information from a programmer.* That is the SDK, shown in Figure 2.

<u>As per claim 5</u>: Incorporated to Claim 1, Microsoft further discloses, *The method according to claim 1 wherein generating the source code further comprises enhancing the source code for the control point.* UPnP Control point SDK is an enhancement of UPnP Control point.

<u>As per claim 6</u>: Incorporated to Claim 1, As suggested by Akkaoui that UPnP allows XML as part of control point, where XML can be used to create a description of a device (See sec. 2, p. 1-2) for disclosing:

The method according to Claim 5 wherein enhancing the source code further

comprises creating a custom eXtensible Markup Language (XML) parser.

As per Claim 7: The claim is storage medium that has the limitations address corresponding the functionality of the method Claim 1. See rationale addressed in Claim 1.

As per Claim 10: Claimed functionality is corresponding to claim 4. See rationale addressed in the rejection of Claim 4 above.

As per Claim 11: Claimed functionality is corresponding to claim 5. See rationale addressed in the rejection of Claim 5 above.

As per Claim 12: Claimed functionality is corresponding to claim 6. See rationale addressed in the rejection of Claim 6 above.

As per Claim 13: The claim is an apparatus that has the limitations address corresponding the functionality of the method Claim 1. See rationale addressed in Claim 1.

As per Claim 16: Claimed functionality is corresponding to claim 6. See rationale addressed in the rejection of Claim 6 above.

As per Claim 17: Claimed functionality is corresponding to claim 4. See rationale addressed in the rejection of Claim 4 above.

As per Claim 18: See the PC that implements Control Point API (i.e. memory).

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The

examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the

Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to

the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an

application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or

Public PAIR. Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center

(EBC) at 866-217-9197 (toll-free).

TTV
November 28, 2008

/Ted T. Vo/
Primary Examiner, Art Unit 2191